UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,417	12/05/2000	Pinky Ma	3626-0127P	6459

2292	7590	06/21/2004		

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EXAMINER
SANTOS, PATRICK J D

ART UNIT	PAPER NUMBER
2171	3

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/729,417	MA ET AL.
	Examiner	Art Unit	
	Patrick J Santos	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 December 2000</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>05 December 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 6, uses the term "mingling process for the sentence elements" (Specification: p. 10, clm. 6, ln. 14). It is unclear as to whether the sentence elements are being mingled, i.e. scrambled amongst themselves, or with another source of elements. If the former is meant, then the claim is not further limiting of Claim 1. If the latter is meant, then the Claim does not state what the sentence elements are being mingled with.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1, 3-4, 6-8, 10-11, 13-15, 17-18, and 20-21 are rejected under 35 U.S.C. 102(e) as

being anticipated by U.S. Patent No. 6,077,085 issued to Parry et al. (hereafter Parry '085).

Claim 1:

        Regarding Claim 1, Parry '085 discloses: a computer-aided language learning method,

comprising:

-   a sentence reading procedure for reading in a first language sentence from a computer

    accessible sentence database (Parry '085: col. 27, lns. 56-60);

-   a sentence partition procedure for performing a sentence element partition subprocedure

    on the first language sentence so as to partition the first language sentence into a plurality

    of sentence elements (Parry '085: col. 23, lns. 17-34);

-   a recombination output procedure for performing a recombination subprocedure on the

    sentence elements and outputting the result of the recombination sub-procedure to a

    learner (Parry '085: col. 23, ln. 61 to col. 24, ln. 3);

-   an input acceptance procedure for accepting the data entered by the learner according to

    the result of the recombination sub-procedure (Parry '085: col. 24, lns. 3-5);

-   a sentence comparison procedure for comparing the learner-input sentence with the first

    language sentence when the data entered by the learner is a learner-input sentence (Parry

    '085: col. 24, lns. 5-9); and

-   a result output procedure for outputting the comparison result of the learner-input

    sentence and the first language sentence to the learner (Parry '085: col. 3, ln. 43 to col. 4,

    ln. 5).

Claims 3-4 and 6-7:

Regarding Claims 3-4 and 6-7, Parry '085 discloses all the limitations of Claim 1 (supra).

Additionally, Parry '085 discloses:

- (Claim 3) the method further comprising: a result recording procedure for storing the
  comparison result of the learner-input sentence and the first language sentence in a
  statistical data table (Parry '085: col. 26, ln. 14 to col. 27, ln. 14).

- (Claim 4) the recombination sub-procedure includes a shuffling process for the sentence
  elements (Parry '085: col. 23, ln. 61 to col. 24, ln. 3).

- (Claim 6) the recombination sub-procedure includes a mingling process for the sentence
  elements (Parry '085: col. 23, ln. 61 to col. 24, ln. 3).

- (Claim 7) wherein

    o the sentence input procedure further comprises inputting a second language
      sentence from the sentence database, the meaning of the second language
      sentence corresponds to that of the first language sentence (Parry '085: col. 27,
      lns. 56-60; col. 13, lns. 57-60); and

    o the recombination output procedure further comprises outputting the second
      language sentence to the learner (Parry '085: col. 13, lns. 57-60).

Claims 8, 10-11, 13-15, 17-18, and 20-21:

Regarding Claims 8, 10-11, 13-15, 17-18, and 20-21, Examiner notes that Claims 8, 10-

11, 13-14 and Claims 15, 17-18, and 20-21 are the "computer-readable storage medium encoded

with executable instructions that can cause a computer to carry out a computer-aided language

learning method" (Parry '085: col. 5, ln. 60 to col. 6, ln. 17; col. 27, lns. 15-20) and "a computer-

aided language learning system" (Parry '085: col. 27, lns. 15-20) embodiments of Claims 1, 3-4,

and 6-7 respectively. As such, Claims 8, 10-11, 13-15, 17-18, and 20-21 are rejected on the

same basis.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 2, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry

'085 in view of U.S. Patent No. 6,154,757 issued to Krause et al. (hereafter Krause '757), in

further view of U.S. Patent No. 5,437,036 issued to Stamps et al. (hereafter Stamps '036).

Claim 2:

Regarding Claim 2, Parry '085 discloses all the limitations of Claim 1 as part of an

"Order Parts Activity" (Parry '085: col. 27, lns. 56-60; col. 23, lns. 17-34; col. 23, ln. 61 to col.

24, ln. 9) (supra). However, Parry '085 does not explicitly disclose:

- a vocabulary data output procedure for inputting a requested vocabulary data from a

     computer accessible vocabulary database and outputting the vocabulary data to the

     learner when the data entered by the learner is a vocabulary inquiry;

- a grammar data output procedure for inputting a requested grammar data from a

     computer accessible grammar database and outputting the grammar data to the learner

     when the data entered by the learner is a grammar inquiry; and

- a phonetics data output procedure for inputting a requested phonetics data from a computer accessible phonetics database and outputting the phonetics data to the learner when the data entered by the learner is a phonetics inquiry.

Krause '757 discloses a means to combine external references to a language learning program (Krause '757: col. 17, lns. 45-60; col. 4, lns. 13-16). Additionally, Krause '757 discloses:

- a vocabulary data output procedure for inputting a requested vocabulary data from a computer accessible vocabulary database and outputting the vocabulary data to the learner when the data entered by the learner is a vocabulary inquiry (Krause '757: col. 3, lns. 35-45; col. 17, lns. 45-60; col. 4, lns. 13-16); and

- a phonetics data output procedure for inputting a requested phonetics data from a computer accessible phonetics database and outputting the phonetics data to the learner when the data entered by the learner is a phonetics inquiry (Krause '757: col. 20, lns. 23-30; col. 4, lns. 13-16).

However, Krause '757 does not explicitly disclose:

- a grammar data output procedure for inputting a requested grammar data from a computer accessible grammar database and outputting the grammar data to the learner when the data entered by the learner is a grammar inquiry; and

Stamps '036 discloses the well known on-line dictionary/thesaurus/grammar checker distributed by Microsoft Corporation (TM). Specifically, Stamps '036 discloses:

- a grammar data output procedure for inputting a requested grammar data from a computer accessible grammar database and outputting the grammar data to the learner

when the data entered by the learner is a grammar inquiry (Stamps '036: col. 3, lns. 17-30); and

It would have been obvious to a person having ordinary skill in the art to apply the vocabulary and phonetics data output procedures of Krause '757 with the Order Parts Activity of Parry '085. The motivation to combine is suggested by Krause '757 which discloses that utilization of the Krause '757 invention provides the advantage that the user is able to "substantially instantaneously change the source of the (Krause '757: col. 15, lns. 39-43).

It would have been further obvious to a person having ordinary skill in the art to apply the grammar data output procedures of Stamps '036 to the Parry '085 and Krause '757 combination. The motivation to combine is suggested by Stamps '036 which discloses that utilization of the Stamps '036 grammar engine is to be added to an arbitrary program such as that of the Parry '085 and Krause '757 combination and provides the advantage of a standard, easy to add set of text checking functionality (Stamps '036: col. 1, lns. 23-50).

Claims 9 and 16:

Regarding Claims 9 and 16, Examiner notes that Claim 9 and Claim 16 are the "computer-readable storage medium encoded with executable instructions that can cause a computer to carry out a computer-aided language learning method" (Parry '085: col. 5, ln. 60 to col. 6, ln. 17; col. 27, lns. 15-20) and "a computer-aided language learning system" (Parry '085: col. 27, lns. 15-20) embodiment of Claim 2 respectively. As such, Claims 9 and 16 are rejected on the same basis.

5.   Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Parry '085 in view of U.S. Patent No. 5,359,514 issued to Manthuruthil et al. (hereafter

Manthuruthil '514).

Claim 5:

        Regarding Claim 5, Parry '085 discloses all the limitations of Claim 1 (supra). However,

Parry '085 does not explicitly disclose the recombination sub-procedure includes a substituting

process for the sentence elements.

        Manthuruthil '514 discloses the recombination sub-procedure includes a substituting

process for the sentence elements (Manthuruthil '514: col. 1, lns. 29-31; col. 1, lns. 38-41 – note

displaying synonyms reads on a substituting process).

        It would have been obvious to a person having ordinary skill in the art to apply

substituting process of Manthuruthil '514 with the method of Parry '085. The motivation to

combine is suggested by Manthuruthil '514 which discloses that utilization of the in-line

synonym apparatus provides the advantage that a user need not revert back and forth between the

reading material and a separate physical dictionary or thesaurus (Manthuruthil '514: col. 1, lns.

42-49).

Claims 12 and 19:

        Regarding Claims 12 and 19, Examiner notes that Claim 12 and Claim 19 are the

"computer-readable storage medium encoded with executable instructions that can cause a

computer to carry out a computer-aided language learning method" (Parry '085: col. 5, ln. 60 to

col. 6, ln. 17; col. 27, lns. 15-20) and "a computer-aided language learning system" (Parry '085:

col. 27, lns. 15-20) embodiment of Claim 5 respectively. As such, Claims 12 and 19 are rejected

on the same basis.

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Patrick J.D. Santos whose telephone number is 703-305-0707.

The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick J.D. Santos
June 9, 2004

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